

REMARKS

Claims 1, 2, 4-6, 8-9, 11-12 and 14 are pending. Claims 3, 10 and 13 were previously canceled, and claim 7 is newly canceled.

The amendment to claim 1 is supported by the canceled claim 7. New claim 14 finds support at paragraph [0042] of this application (U52006/0139846).

No new matter has been added by way of the above-amendment.

Claim Objections

The Examiner has objected to claim 1 due to certain informalities as noted in the current Office Action at page 4. Specifically, the Examiner objects to this claim because the limitation “there is a solids content of 50% or more by weight” is unclear. In addition, the Examiner objects to this claim because it is not clear what total weight the percentage refers to – the weight of the particulate elastomer and the carbonaceous material or the particulate elastomer, carbonaceous material, and the non-liquid components of the powdery mixture.

The Examiner will note that claim 1 has been amended to address the Examiner's concerns. As such, reconsideration and withdrawal of the objection are respectfully requested.

Issues Under 35 U.S.C. § 103

The following prior art rejections have been maintained:

(A) Claims 1-2, 4, 7 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshika et al. (JP 11-162794, hereinafter “Yoshika”; see Applicant-submitted translation);

(B) Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshika, as applied to claim 4, above, and further in view of Sonobe et al. (US 6,258,337 B1, hereinafter “Sonobe”); and

(C) Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshika, as applied to claim 1, above, and further in view of Moriguchi et al. (US 2001/0051300 A1, hereinafter "Moriguchi").

Applicants respectfully traverse the rejections.

1) Legal analysis

M.P.E.P. § 2143 sets forth the guidelines in determining obviousness. First, the Examiner has to take into account the factual inquiries set forth in *Graham v. John Deere*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), which has provided the controlling framework for an obviousness analysis. The four *Graham* factors of: determining the scope and content of the prior art; ascertaining the differences between the prior art and the claims that are at issue; resolving the level of ordinary skill in the pertinent art; and evaluating any evidence of secondary considerations (e.g., commercial success; unexpected results). 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). Second, the Examiner has to provide some rationale for determining obviousness, wherein M.P.E.P. § 2143 set forth some rationales that were set established in the recent decision of *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007). Here, the Examiner has not appropriately resolved the *Graham* factors, including ascertaining the differences between the prior art and the claims that are at issue.

2) "The resultant powdery mixture" in present claim 1 is not disclosed in Yoshika

The resultant powdery mixture of the present invention has composite particles of the carbonaceous material and the particulate elastomer. That is, in the resultant powdery mixture, the particulate elastomer is evenly adsorbed on the carbonaceous material thereby the carbonaceous material and the particulate elastomer are kept in a powder form.

For example, the particulate elastomer may be sprayed in order to evenly adsorb the particulate elastomer on the carbonaceous material. Please note that "spraying the particulate elastomer" could involve "spraying the particulate elastomer onto the carbonaceous material", as

well as "spraying the mixture including the particulate elastomer and the carbonaceous material, thereby granulating the mixture so as to obtain the resultant powdery mixture."

Yoshika fails to teach or fairly suggest that the particulate elastomer is evenly adsorbed on the carbonaceous material.

3) The particle diameter of the resultant powdery mixture

In order to further distinguish the present invention from the teachings of Yoshika, Applicants have amended claim 1 to recite the subject matter of claim 7, that is to recite that the particle diameter of the powdery mixture is 1.0-1000 μm .

At page 7 of the outstanding Office Action, the Examiner states:

Yoshika discloses that said powdery mixture has a particle diameter of 0.1 to 1000 μm .

However, Applicants respectfully submit that the Examiner misunderstands the teachings of Yoshika and/or the present invention.

Present claim 1 defines a particle diameter of "the resultant powdery mixture". As stated above, in the resultant powdery mixture, the particulate elastomer is evenly adsorbed on the carbonaceous material, resulting in the carbonaceous material and the particulate elastomer being kept in a powdery form.

On the other hand, Yoshika only discloses a particle diameter of the "binder". There is no teaching or suggestion by Yoshika of a particle diameter of a "powdery mixture" in which the elastomer is adsorbed on the carbonaceous material.

As such, significant patentable distinctions exist between the present invention and the teachings of Yoshika.

The Examiner, aware of certain deficiencies of Yoshika, cites Sonobe and Moriguchi to cure those deficiencies. Since the Examiner cites Sonobe for teaching the subject matter of claims 5 and 6, and the Examiner cites Moriguchi for teaching the subject matter of claims 8 and 9, neither Sonobe nor Moriguchi cure the deficiencies of Yoshika as set forth above.

In view of the fact that all of the limitations of claim 1, as presently amended, are neither taught nor fairly suggested by Yoshika, when taken alone or in combination with Sonobe or Moriguchi, a *prima facie* case of obviousness cannot be said to exist. Reconsideration and withdrawal of the rejections are respectfully requested.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Garth M. Dahlen, Ph.D., Esq., Reg. No. 43,575, at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

By 

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